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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

GUY BEVENTE, MICHAEL THANE-PAQUETTE, GREGG R.
KOEPPEN, DOUGLAS ROBERT MORAN, DANNY LEE ROPER,
KIMBERLY RENEE WOLKEN, and JENNIFER LYNN ANDERSON

Appeal 2008-2804
Application 10/654,859
Technology Center 3700

Decided: September 12, 2008

Before DONALD E. ADAMS, RICHARD M. LEOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-38 as obvious over prior art. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Claims 1-38 are pending and appealed. The claims stand rejected as follows:

1) Claims 1-7 and 10-38¹ under 35 U.S.C. § 103(a) as obvious over Friedes (US 5,771,282, issued Jun. 23, 1998) and Plush et al. (US 6,965,764 B2, issued Nov. 15, 2005) (Ans. 3); and

2) Claims 8 and 9 under 35 U.S.C. § 103(a) as obvious over Friedes, Plush, and Jagadish (US 5,844,972, issued Dec. 1, 1998) (Ans. 7).

Claims 1, 8, 9, 34, and 36 are representative and read as follows:

1. A method of providing a bill to a telecommunications subscriber, the method comprising:

distributing a bill including shared account information to the telecommunications subscriber, the shared account information identifying shared telecommunication units used in connection with a first subscriber service and a second subscriber service, the first subscriber service being distinct from the second subscriber service.

8. The method of claim 1, wherein the shared telecommunication units are used in connection with a third subscriber service.

9. The method of claim 1, wherein the third subscriber service is a calling card service.

34. A telecommunications subscriber service package comprising:
an allocation of unshared account units for use of a first subscriber service; and

an allocation of shared account units for use of a second subscriber service and available for use of the first subscriber service.

¹ Claims 8 and 9 were included in the Examiner's statement of the rejection (Ans. 3). However, claims 8 and 9 were not addressed in this rejection, but were separately rejected in another rejection which relied on the same two cited references plus an additional reference.

36. The telecommunication subscriber service package of claim 34 wherein the allocation of unshared account units is utilized by the first subscriber service prior to utilization of the allocation of shared account units by the first subscriber service.

OBVIOUSNESS OVER FRIEDES AND PLUSH

Claims 1-7 and 10-38 stand rejected under 35 U.S.C. § 103(a) as obvious over Friedes and Plush.

Claims 1-5, 10, and 12-15

The scope and content of the prior art

THE FRIEDES PATENT

1. Friedes describes a system “for aggregating the billing for [telecommunication] services . . . made from telephone stations having different identifiers (e.g., different telephone numbers)” but associated with the same common subscriber (Friedes, at col. 1, ll. 61-64; at col. 4, ll. 13-28).
2. In a preferred embodiment, Friedes describes billings for “wired” and “wireless” telephone stations aggregated on the same bill for the same subscriber (Friedes, at col. 2, ll. 30 to col. 4, l. 57; *see id.* at col. 2, ll. 34 and 48; *see* Figure 1).
3. The billing information includes the telephone number originating the call, the length of the call, and the time at which the call was made (Friedes, at col. 3, ll. 43-50).
4. Charges for other “unrelated” services provided by different service providers can also be aggregated with the telecommunications charges, such as for satellite television services and telephone credit calls (Friedes, at col. 4, l. 58 to col. 5, l. 14).

THE PLUSH PATENT

5. Plush describes a billing center for a mobile communications system which generates billing data for a group of users sharing a single account (Plush, Abstract).
6. Various subscription types are described in Plush, including a type in which a “bundle” of pre-paid minutes is shared by subscribers to a group subscription (Plush, at col. 4, ll. 10-52; at col. 5, ll. 44-51).
7. The billing report in Plush associates the telephone number and call details for each subscriber within the group (Plush, at col. 4, ll. 1-9).
8. The report also indicates the total bundle time used by each subscriber in the group to monitor the usage as a group and by group member (Plush, at col. 7, l. 48 to col. 8, l. 6).
9. Plush’s system identifies a call, its duration, and determines whether there is bundle time remaining; if so, the call time is subtracted from the remaining usage allocation in the bundle record (Plush, at col. 6, ll. 4-35).
10. If the bundle time has been exceeded, Plush teaches that its rating application retrieves “tariff” information to calculate the charge for the call (Plush, at col. 6, ll. 13-21); in other words, when the shared usage is exhausted, Plush describes how to calculate the cost of additional call time.
11. Plush describes its system as providing “charging structures which are flexible, easy to understand, and logical, may be implemented for associated groups of subscribers in a mobile communications system” (Plush, at col. 1, ll. 58-61).
12. Plush also states that its data-processing apparatus “provides . . . usage allocation [that] may be allocated not only to a single subscriber, but by groups of subscribers of various sizes, thereby allowing flexibility and the

utilisation of usage allocations in accordance with the desires of different groups of subscribers” (Plush, at col. 2, ll. 25-31).

Differences between the claimed invention and the prior art

13. Friedes teaches aggregating billing information (*i.e.*, “shared account information”) from wired and wireless subscriber (*i.e.*, “first subscriber” and “second subscriber” services” (FF1, 2) as in claim 1, but does not teach the claimed limitation of “shared telecommunication units used in connection with” the first and second subscriber services (*see* App. Br. 4-5).

14. The difference between Plush and claim 1 is that Plush does not describe sharing minutes between different subscriber services as in claim 1 (*i.e.*, “shared telecommunication units used in connection with a first subscriber service and a second subscriber service”), but instead teaches sharing minutes within the same service and subscription group.

Reason to combine Friedes and Plush

15. Plush’s teaching that different telephone directory numbers can share minutes (FF5-8) would have been recognized by persons of ordinary skill in the art as applicable to situations where the telephone numbers are associated with different subscriber services, *i.e.*, wired and wireless services, as in Friedes (FF1-2).

16. Persons of ordinary skill in the art would have had reason to share minutes between the first and second subscriber services of Friedes, and thus reach the limitation of claim 1 of “shared telecommunication units”, for the flexibility and adaptability of shared usage allocations as taught by Plush (FF11, 12; *see* Ans. 4).

Analysis

The issue in this rejection is whether it would have been obvious to persons of ordinary skill in the art to have applied Plush's shared usage system, in which minutes are shared between different telephone numbers in the same service and subscription group, to Friedes' system in which different subscription services are aggregated on the same bill. That is, would it have been obvious to share minutes between wired and wireless services when the prior art teaches sharing minutes between users of the same telephone service?

A determination of obviousness generally requires a reason that would have prompted persons of ordinary skill in the art to have combined the prior art to have made the claimed invention. In this case, the Examiner finds that persons of ordinary skill would have had reason to modify Friedes' with Plush's shared usage system "because it would provide an apparatus whereby charging structures which are flexible, easy to understand, and logical, may be implemented for associated groups of subscribers in a mobile communications system ([Plush, at] col. 1, lines 57-60)" (Ans. 4; *see* FF12, 13, 16).

As the Examiner has provided a logical reason as to why persons of ordinary skill in the art would have been prompted to combine Friedes and Plush in the way that the claimed invention does, we conclude that *prima facie* obviousness of the claimed subject matter has been established. Consequently, we turn to Appellants' rebuttal evidence and arguments.

Appellants state that "Plush does not disclose or suggest shared account information identifying shared telecommunication units **used in**

connection with a first subscriber service and a second subscriber service, as recited by independent claim 1” (App. Br. 5).

Appellants’ characterization of Plush is correct (*see* FF14). However, the Examiner’s position is that Plush’s teaching about shared minute usage between a group of users of the same telephone service reasonably suggests sharing usage between different telephone services. In other words, Plush’s teaching that different telephone directory numbers can share minutes would have been recognized by persons of ordinary skill in the art as applicable to situations where the telephone numbers are associated with different types of telephone services, i.e., wired and wireless services, as in Friedes (FF15). While there is no express suggestion to do so, we find that extrapolating from Plush’s system to Friedes would have been reasonable in view of the fact that both prior art references relate to telephone systems and the advantages of bundling minutes and usage allocation as described by Plush (FF11-12). Other than characterizing the differences between Plush and the claimed invention, Appellants have not identified a flaw in the Examiner’s explicit reason for why persons of ordinary skill in the art would have been prompted to combine Friedes with Plush.

For the foregoing reasons, we affirm the rejection of claim 1. Claims 2-5, 10, and 12-15 fall with claim 1 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 6

Claim 6 is directed to the method of claim 1, “wherein the bill further comprises charges for usage in excess of available shared telecommunication units identified by the shared account information.” Plush describes charges for a call when the shared time bundle is exhausted

(FF10), explicitly meeting the claim limitation. Thus, we do not agree with Appellants that this limitation is not described in the cited prior art (Reply Br. 3). We affirm the rejection of claim 6.

Claim 7

Appellants contend that

none of the cited references, alone or in combination disclose or suggest shared telecommunication units used in connection with two subscriber services, or determining whether a sum of the first subscriber service usage and the second subscriber service usage exceeds the shared telecommunication units, as recited by dependent claim 7.

(App. Br. 6.)

Plush explicitly teaches determining whether the usage of different users within the same shared account exceed the shared allocation of telecommunications units (FF9-10), but not from different services as in claim 1. However, the Examiner provided a reason as to why Plush's shared usage system would be applied to Friedes's teaching about aggregating different subscription services (*see* Ans. 4; FF11, 12, 16). Appellants have not identified a flaw in this reasoning.

The Examiner cited column 4, lines 49-57 of Friedes for "determining whether the sum of the first subscriber usage and the second subscriber usage exceeds the shared telecommunication units" (Ans. 5). Appellants urge that this disclosure cannot be found at this location (Reply Br. 2). Nonetheless, this aspect is clearly taught by Plush (FF9-10), whose entire disclosure was cited by the Examiner in support of the rejection. Accordingly, we affirm the rejection of claim 7.

Claim 11

Claim 11 further recites that “the second set of telecommunication units is applied to usage of the second subscriber when the combined usage of the first subscriber service and the second subscriber services exceeds the shared telecommunication units.” Pointing to Figure 1 of Friedes, the Examiner states that “Friedes inherently discloses” the subject matter of claim 11 (Ans. 5). Appellants contend that “Friedes makes no mention of a second set of telecommunication units” and thus Friedes does not inherently disclose the claimed limitation (Reply Br. 3).

We acknowledge Appellants’ argument, but nonetheless find this limitation is clearly taught by Plush, whose entire disclosure was cited by the Examiner in support of the rejection. Plush describes utilizing another (and therefore second) set of telecommunication units when the shared usage is exhausted (FF10). Since these minutes could be applied to either subscriber, we find that the limitation of “a second set of telecommunication units is applied to usage of the second subscriber” is satisfied. Thus, we affirm the rejection of claim 11.

Claim 16

Claim 16 is directed to a method of claim 1 in which “the first subscriber service is associated with a first operating entity and the second subscriber service is associated with a second operating entity.”

The Examiner contends that first and second operating entities are disclosed in Friedes and cites Friedes’s Abstract as evidence of this (Ans. 6). Appellants contend that the Friedes’s Abstract does not disclose this limitation (Reply Br. 3-4).

While it may be true that the Friedes's Abstract does not refer to first and second operating entities, Friedes's disclosure does in fact suggest the claimed limitation. At columns 4-5, Friedes describes how billing information from different service providers – i.e., different operating entities as in claim 16 – could be aggregated on the same bill (FF4). Thus, we agree with the Examiner's conclusion that aggregating billing information from different operating entities is reasonably suggested by Friedes's disclosure. The rejection of claim 16 is affirmed.

Claims 17, 18, 24, and 27-33

Independent claim 17 is drawn to a telecommunication subscriber service package in which “at least a portion of the allocation of shared account units available for use of a first subscriber service and available for use of a second subscriber service, the first subscriber service being distinct from the second subscriber service.”

The Examiner concluded that this claim was obvious for the same reasons as for claim 1 (Ans. 3-4). Appellants, again, characterize the differences between Plush and claim 17 as the former teaches that “pre-paid allotment of minutes may be used only within its associated subscription service type” but “fails to teach or suggest” the claimed limitation of first and second subscriber services (App. Br. 7).

This argument is not persuasive. Appellants have identified differences between the claimed invention and prior art, but have not explained why the Examiner erred in finding reason to have combined Friedes with Plush to have made the claimed invention. Having considered the Examiner's reason for combining the prior art and determining it be

sufficient to establish prima facie obviousness of claim 1, we find that the same determination holds true for claim 17. The rejection of claim 17 is affirmed. Claims 18, 24, and 27-33 fall with claim 17 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

Claims 19-23, 25, and 26

In regard to claims 19, 22, 23, 25, and 26, Appellants state that the cited prior art does not disclose the specific limitations recited in the claims (*see* App. Br. 8; Reply Br. 4-5).

“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” 37 C.F.R. § 41.37(c)(1)(vii). Consequently, as Appellants have simply pointed out the limitations in the claims, we affirm the rejections of claims 19, 22, 23, 25, and 26 for the same reasons as for claim 17 upon which these claims directly or indirectly depend. Claims 20 and 21 fall with claims 19, 22, 23, 25, and 26 because these claims were not separately addressed. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 33

Independent claim 33 involves “shared telecommunication minutes used in connection with a first subscriber service and a second subscriber service” in which the first service is “wireless phone service” and the second service is “landline long distance service.” The Examiner concluded that this claim was obvious for the same reasons as for claim 1 (Ans. 3-4). Appellants argue as they did for claim 1, but further distinguish the claimed subject matter from the prior art because of the additional limitations to the wireless and landline services (App. Br. 8-9; Reply Br. 5-6). However,

Friedes teaches wireless and wired connections (FF2) as in claim 33. Thus, we conclude that claim 33 is obvious for the same reasons as for claim 1.

The rejection is affirmed.

Claims 34 and 35

For independent claim 34, Appellants argue that “Plush fails to teach or suggest an allocation of shared account units for use of a first subscriber service and available for use of a second subscriber service, as recited by independent claim 34” (App. Br. 10).

This argument is not persuasive. The shared units described in Plush, which are used by a user in the same subscription group, are also available to a second user. As acknowledged by the Examiner, Plush does not describe sharing minutes between different subscription services (FF14). However, this feature is taught by Friedes and the Examiner provided a reason as to why Plush’s shared system would be applied to Friedes (*see* Ans. 4; FF15-16). Appellants have not identified a flaw in this reasoning. Consequently, we affirm the rejection of claim 34.

In regard to claim 35, Appellants merely restate what the claim recites without explaining why the Examiner erred in rejecting it. “A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.” 37 C.F.R. § 41.37(c)(1)(vii). Consequently, we affirm the rejection of claim 35 for same reasons as for claim 34 upon which it depends.

Claims 36-38

Claims 36-38, each which depend on claim 34, recite different limitations as to the allocation of shared and unshared account units. Appellants contend that the Examiner did not “provide a specific basis for

rejecting” these claims over the combination of Friedes and Plush (Reply Br. 6-7).

The Examiner did not meet the burden of establishing prima facie obviousness of claims 36-38. On page 6 of the Answer, the Examiner refers to the rejection of claim 1 for support of the rejection of claims 36-38. The Examiner further states that “Plush discloses a telecommunication system that includes shared and unshared account units as claimed” (Ans. 6). However, the Examiner does not point to the disclosure that is asserted to meet the specific claim limitations recited in claims 36-38 nor explain why such limitations would have been obvious to one of ordinary skill in the art. Because of these shortcomings, we are compelled to reverse the rejection of claims 36-38.

OBVIOUSNESS OVER FRIEDES, PLUSH, AND JAGADISH

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as obvious over Friedes, Plush, and Jagadish.

Scope and content of the prior art

THE JAGADISH PATENT

17. Jagadish describes a calling card service (Jagadish, Abstract).

Difference between the claimed invention and the prior art

18. The difference between claim 9 and Friedes is that Friedes does not describe a calling card service as a third subscriber service as in claim 9.

Reason to combine

19. The Examiner finds that one of ordinary skill in the art would have had reason “to utilize the calling plans subscription as taught by Jagadish into the system of Friedes because it would provide a system in which calls made by a customer using a calling card or a prepaid telephone card are billed in accordance with the customer’s subscribed calling plans” (Ans. 7).

Analysis

Appellants contend:

Jagadish fails to overcome the deficiencies of the combination of Friedes and Plush. Jagadish does not disclose or suggest a “shared account information identifying shared telecommunication units used in connection with a first subscriber service and a second subscriber service,” as recited by independent claim 1. Instead, Jagadish discloses that calls made by a customer, using a calling card or prepaid card, are billed according to the customer's calling plan. *See Jagadish*, col. 1, lines 21 -36. Accordingly, the asserted combination of Friedes, Plush, and Jagadish fail to disclose or suggest each and every element of claim 1, and of claims 8 and 9, at least by virtue of their dependency from claim 1.

(Reply Br. 8.)

This argument does not convince us that the Examiner erred. The Examiner provided an express reason for combining the cited prior art (FF19). Appellants have not identified a flaw in this reasoning. The Examiner does not rely on Jagadish for teaching the shared account and shared telecommunication units of claim 1 as asserted by Appellants (*see* Reply Br. 8 above), but relies on it for its disclosure of a calling card as specifically recited in claim 9. Because Friedes teaches that other services can be aggregated with wired and wireless services, including telephone

credit cards (FF4), Friedes reasonably suggests an aggregated a card service as described by Jagadish, which is the same type of service provided by a telephone credit card. Accordingly, we affirm the rejection of claims 8 and 9.

CONCLUSION

In summary, we affirm the rejections of claims 1-35 and reverse the rejections of claims 36-38.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

cdc

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